

ADMINISTRATIVE PANEL DECISION

Raffaele Caruso S.p.A. v. Name Redacted
Case No. D2024-4683

1. The Parties

The Complainant is Raffaele Caruso S.p.A., Italy, represented by Società Italiana Brevetti, Italy.

The Respondent is Name Redacted.

2. The Domain Name and Registrar

The disputed domain name <itcarusomenswear.shop> is registered with Sav.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 13, 2024. On November 14, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 14, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (REDACTED FOR PRIVACY) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 15, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on November 19, 2024.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 21, 2024. In accordance with the Rules, paragraph 5, the due date for Response was December 11, 2024. On December 2, 2024, the Center received a communication from a third party regarding apparent identity theft in the registration of the disputed domain name. No formal Response was received from the Respondent.

Pursuant to paragraph 6 of the Rules, on December 12, 2024, the Center informed the Parties that it would proceed with the panel appointment process.

The Center appointed Zoltán Takács as the sole panelist in this matter on December 19, 2024. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is an Italian joint stock company founded in 1958 by Raffaele Caruso.

The atelier which started with making tailor-made men's suits grew over the years to a company of about 500 employees.

The Complainant's portfolio of CARUSO trademarks includes, among others, the International Trademark Registration No. 1015735, registered since August 27, 2009.

The Complainant is also owner of a number of domain registrations that include its CARUSO mark. For example, the domain name <carusomenswear.com>, which was registered on May 15, 2009, resolves to its corporate website.

The disputed domain name was registered on June 14, 2024, and has been used for a predominantly Italian language website that apparently offers for sale clothing articles and other goods related to the clothing industry.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that:

- the disputed domain name, which incorporates its CARUSO mark is confusingly similar to it because the addition of the abbreviation "it", the two-letter country code for Italy and the term "menswear" is not sufficient to distinguish the disputed domain name from the trademark;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name and is unable to rely on any of the circumstances set out in paragraphs 4(c)(i), (ii) or (iii) or the Policy; and
- the Respondent's misappropriation of its trademark in order to create a likelihood of confusion by suggesting to Internet users that the website at the disputed domain name relates to the Complainant is evidence of bad faith.

The Complainant requests that the disputed domain name be transferred from the Respondent to the Complainant.

B. Respondent

Following the Notification of the Complaint, an individual with the same name as identified by the Registrar as the registrant of the disputed domain name sent an email to the Center on December 2, 2024, stating

among others to have no knowledge of the disputed domain name, nor owns or manages any domain names.

Since it appears that the actual registrant of the disputed domain name has during registration of the disputed domain name usurped the identity of the person mentioned above the Panel has – in light of the potential identity theft – redacted the Respondent's name from this decision.

However, the Panel has attached Annex 1 to this decision instructing the Registrar to transfer the disputed domain name which includes the name of the Respondent. The Panel has authorized the Center to transmit Annex 1 to the Registrar, as part of the order in this proceeding and with an indication that it shall not be published due to the exceptional circumstances of this case. See *Banco Bradesco S.A. v. FAST-12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#).

6. Discussion and Findings

In order to succeed on a complaint a complainant must evidence each of the three elements required by paragraph 4(a) of the Policy, namely that:

- (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in respect of the domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Complainant's trademark is replicated and clearly recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, here the abbreviation "it", which is the two-letter country code for Italy, and the term "menswear" may bear on assessment of the second and third elements, the Panel finds that the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the

respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

The record contains un rebutted information that the actual registrant of the disputed domain name has engaged in identity theft by adopting a third party's personal name and contact information. UDRP panels have held that the use of a domain name for illegal activity, here identity theft, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Panel finds that the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Panels have held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include identity theft, which as previously discussed appears to have occurred during the registration of the disputed domain name. [WIPO Overview 3.0](#), section 3.4.

Since the individual confirmed by the Registrar as the registrant of the disputed domain name explicitly stated to have no knowledge of the disputed domain name and no other person filed a response to the Complaint, the Panel finds that the present case constitutes bad faith registration and use especially because of identity theft.

Besides the above mentioned, the Panel is convinced that the actual registrant of the disputed domain name has registered it with the Complainant's rights in mind. This is especially supported by the fact that the actual registrant of the disputed domain name used in creation of the disputed domain name the abbreviation "it" (country-code identifier of Italy, the Complainant's country of origin) and the term "menswear", which directly refers to the Complainant's core business.

The actual registrant has been using the disputed domain name, which includes the Complainant's trademark and is almost identical with the Complainant's domain name to confuse Internet users with an association with the Complainant and its trademark. Such targeting of the Complainant and its trademark is fraudulent and clear evidence of bad faith.

The Panel finds that the Complainant has established the third element of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <itcarusomenswear.shop> be transferred to the Complainant.

/Zoltán Takács/

Zoltán Takács

Sole Panelist

Date: January 2, 2025